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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/034,000      | 12/20/2001  | Christopher R. Haczynski | 072063.00001        | 1836             |

7590 10/07/2003  
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EXAMINER

LUGO, CARLOS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3677

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/034,000

Applicant(s)

HACZYNSKI ET AL.

Examiner

Carlos Lugo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on July 23, 2003.

#### *Specification*

2. The specification is objected to because of the following informalities:

- Page 6, it is unclear the purpose and the relations of the flat surface with each tumbler to obtain a number and the purpose of the table at Page 6. An example or a better presentation of how to interpret the table is required.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 1-7 and 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,170,884 to Calegan.

Regarding claims 1-4 and 9, Calegan discloses the combination of a bottom tumbler and nose element (37 and 50) and a knob and dial element (16).

The knob and dial element comprises a knob portion having an axially extending female recess (51).

The bottom tumbler and nose element comprises a nose portion (50) that is inserted into the female recess.

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However, Calegan fails to disclose that the female recess has a plurality of varying formations symmetrically disposed around the circumferential surface of the recess that will mate with a plurality of varying formations symmetrically disposed around the circumferential surface of the nose portion.

Calegan disclose that the female recess has a cylindrical surface that mate with the cylindrical surface of the nose portion. However, Calegan also disclose that the nose portion could have a flat surface that engages a similar flat surface in the female recess (Col. 4 Lines 3-5).

Applicant is reminded that the duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have more that one flat surface or varying formation because it is consider a design choice that will not affect the engagement of the female recess and the nose portion.

As to claims 5 and 6, Calegan discloses that the knob and dial element (16) and the bottom tumbler and nose element (37 and 50) are integrally formed.

As to claim 7, Calegan discloses that the combination further includes means (52 and 53) for permanently affix the knob recess to the tumbler nose.

5. **Claim 8 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,170,884 to Calegan in view of US Pat No 252,336 to Thurman.

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Calegan fails to disclose the use of a rivet to for permanently affix the knob recess to the tumbler nose.

Thurman teaches that is known in the art to use a rivet (g') to permanently affix the knob recess to the tumbler nose.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rivet, as taught by Thurman, into a combination as described by Calegan, in order to permanently affix the knob recess to the tumbler nose.

6. **Claim 10 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,170,884 to Calegan in view of US Pat No 5,522,243 to Kusmiss.

Calegan discloses that the dial is marked with a predetermined number of indicia (numbers).

However, Calegan fails to disclose that the predetermined number of indicia is equal or greater than the number of positions of the elements.

Kusmiss teaches that is known in the art to have a predetermined number of indicia equal or greater than the number of positions of the elements (Col. 5 Lines 48-55).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a dial element, as taught by Kusmiss, into a combination as described by Calegan, in order to have a more numbers to use and more combination options.

***Response to Arguments***

7. Applicant's arguments filed on July 23, 2003 have been fully considered but they are not persuasive.

Regarding applicant's arguments that the rejection of the claims in view of Calegan has to be withdrawn (Page 12 Line 27), the rejection is maintained.

Claim 1 just claims a knob and dial element comprising a knob portion having an axially extending female recess, a bottom tumbler and nose element comprising a nose portion that is inserted into the female recess, and that the female recess has a plurality of varying formations symmetrically disposed around the circumferential surface of the recess that will mate with a plurality of varying formations symmetrically disposed around the circumferential surface of the nose portion. In other words, just the connection and interaction between the female recess and the nose portion. The claims do not recite the relation of how theses plurality of surfaces will affect the combination of the padlock. Then, the rejection of the claims in view of Calegan, as a duplication of components, is valid because it is understand by the claim that is just having more surfaces on the nose portion and in the recess.

As to applicant's arguments that that the invention will achieve a dramatic drop in inventory and cost (Page 13 Line 3), the applicant has to submit prove of that in order to be considered.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

Carlos Lugo  
Examiner  
Art Unit 3677

October 2, 2003.

  
J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600